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No. 90-326

IN THE

Supreme Court Of The United States

OCTOBER TERM, 1989

DATAPOINT CORPORATION,

Petitioner,

v.

NORTHERN TELECOM INC.,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

BRIEF IN OPPOSITION OF RESPONDENT NORTHERN TELECOM INC. TO PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Petitioner's statement of the questions presented attempts to create issues of importance and to manufacture conflicts with the Federal Rules of Civil Procedure and Supreme Court precedent where none exists.

Restated, the question presented is nothing more than whether the Federal Circuit properly reversed the district court's holding that certain claims of U.S. Patent No. 3,760,375 ('375 patent) were invalid for lack of "enablement" under 35 U.S.C. § 112, where the expert testimony, including the testimony of Datapoint's own witnesses, supported a conclusion of validity under the statute.

RULE 29.1 STATEMENT

Respondent Northern Telecom Inc. is a wholly owned subsidiary of Northern Telecom Limited, a corporation incorporated under the laws of Canada having its principal offices at 3 Robert Speck Parkway, Mississauga, Ontario, Canada L4Z 3C8.

Northern Telecom Inc. has the following subsidiaries (other than wholly owned subsidiaries):

NYNEX Meridian Systems
6 Century Drive
Second Floor
Parsippany, NJ 07054

(80% owned by Northern Telecom Inc.)

Sanko Telecom Co., Ltd.
Kokasai Shin-Akasaka Building
1-20 Akasaka 6-Chome
Minato-ku, Tokyo 107
JAPAN

(20% owned by Northern Telecom Inc.)

Sumisho Electronics Co. Ltd.
3-11 Kanda Nishiki-cho
Chiyoda-ku, Tokyo 101
JAPAN

(19% owned by Northern Telecom Inc.)

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REASONS FOR DENYING THE WRIT

This case presents no issue worthy of review by the Supreme Court. Specifically, the decision in this case does not conflict with the decision of another court, involves no constitutional questions, and presents no important questions of federal law that must be settled by this Court. Instead, the petition of Datapoint Corporation (Datapoint) contains nothing more than the familiar refrain of a losing litigant on appeal.

Datapoint's petition seeks to create a basis for exercise of the Supreme Court's jurisdiction by alleging that the Court of Appeals for the Federal Circuit failed to adhere to the "clearly erroneous" standard of Rule 52(a), Fed. R. Civ. P., and certain precedents of this Court. By now, the Court should easily recognize this tactic of losing litigants in the Federal Circuit who have no real grounds for requesting

Supreme Court review.

The creation of the Federal Circuit in 1982 removed a primary ground for Supreme Court review, namely conflicting precedent between circuits in the area of substantive patent law. As a result, losing litigants in the Federal Circuit have unsuccessfully tried to use Rule 52(a) as a way to obtain review. Datapoint itself cites several such unsuccessful attempts in 1987. (Datapoint Petition, at p. 9, n.13).[1]

Rather than showing the Federal Circuit's "well-known predilection for fact finding" as Datapoint asserts (Datapoint Petition, at p. 9), it shows only that the Supreme Court has previously rejected similar allegations as being insufficient grounds for granting review. Thus, Datapoint's assertion that "this Court has not previously considered a Federal Circuit opinion to assess that appellate court's role in reviewing findings permeated with determinations of credibility" (Datapoint Petition, at p. 9) is only half true. It is true that the Court has not issued a writ of certiorari based on such grounds, but it is also true that such grounds have often been considered and rejected by the Court as being unworthy of review.

The principal thrust of Datapoint's petition is that the Federal Circuit erroneously substituted its view of factual findings and ignored the district court's crucial findings based on the credibility of witnesses. These contentions are completely without merit. Indeed, the Federal Circuit denied Datapoint's Petition for Rehearing and Suggestion for Rehearing In Banc on the very same grounds.

Datapoint ignores the portion of the Federal Circuit's opinion which states that "the great weight of the expert testimony *on both sides*" supports the legal conclusion that U.S. Patent No. 3,760,375 ('375 patent) was fully enabling under 35 U.S.C. § 112.[2] (Opinion,

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[1] In *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986), the Court granted a petition for certiorari and vacated (not reversed) the Federal Circuit's decision for further consideration in light of Rule 52(a). On remand, the Federal Circuit reaffirmed its previous decision, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986), and the Supreme Court denied review, 481 U.S. 1052 (1987).

[2] 35 U.S.C. § 112, first paragraph, provides in relevant part that:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear,

(Footnote Con't)

at p. 18a; emphasis added). Thus, the Federal Circuit did not have to pick and choose between expert testimony because virtually every expert witness, including Datapoint's own experts, testified in such a way as to support a conclusion of patent validity.

Datapoint criticizes the Federal Circuit for relying on the testimony of three witnesses, namely Gordon Bell, Earle Pughe, and Fernando Corbato, who were not specifically mentioned as being credible witnesses by the district court in connection with its conclusion on enablement under § 112. (Datapoint Petition, at p. 8). Each of these witnesses testified that it would be relatively straightforward for a skilled computer programmer to carry out the claimed invention.[3] (Opinion, at p. 17a). What Datapoint omits from this discussion, however, is that *Bell, Pughe, and Corbato were all Datapoint witnesses.*

Even the testimony of Datapoint's expert witness Dr. Kay Magleby, who the district court found "persuasive and credible," supports a conclusion that the '375 patent specification was fully enabling to one of ordinary skill in the art. The testimony of Datapoint's other witness, Prof. Wesley Clark, was discounted by the Federal Circuit, not as a matter of credibility, but for its inconsistency with binding precedent interpreting the statutory requirements of § 112 as applied to computer programs. *See In re Sherwood*, 613 F.2d

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concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

[3] Datapoint accuses the Federal Circuit of "openly enag[ing] in unwarranted fact finding" because the court cited Bell's deposition testimony rather than his trial testimony. (Datapoint Petition, at p. 8). As Datapoint points out, Bell changed his position at trial because he had not considered the memory constraints of the patent during his deposition. (*Id.*)

What the Federal Circuit realized, however, is that Bell's later trial testimony concerning the size of the memory is irrelevant to the enablement issue. The proper question under § 112 is whether the patent disclosure is sufficient to enable those skilled in the art to practice the *claimed* invention. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). The size of the memory is not recited in the claims. Therefore, Bell's later testimony regarding an ordinary programmer operating under "intense memory constraints" was correctly disregarded by the Federal Circuit as being directed to the wrong legal standard.

809, 817 (C.C.P.A. 1980), *cert. denied*, 450 U.S. 994 (1981). Completely absent from Prof. Clark's testimony was any evidence of the *amount* of experimentation required to practice the claimed invention.

Furthermore, Datapoint fails to reconcile its position on the credibility of witnesses with the fact that enablement under § 112 is a *question of law*. *See, e.g., Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir.), *cert. denied*, 484 U.S. 809 (1987). Because enablement is a question of law, expert opinions on that ultimate legal question are not determinative. *See In re Brandstadter*, 484 F.2d 1395, 1405 (C.C.P.A. 1973) (rejecting legal opinion on ultimate question of enablement).

Thus, there is more to the enablement issue, as with all legal issues, than merely judging the credibility of witnesses as Datapoint suggests. Otherwise, a district court could effectively insulate itself from appellate review by simply relying on the credibility of witnesses in reaching its legal conclusion. This would prevent the Federal Circuit from reversing in a case such as this where, credible witnesses or not, Datapoint had failed to show that the '375 patent did not meet the statutory requirements of enablement under § 112.

By filing a petition for certiorari on such flimsy grounds, where it knows that the Court has previously denied certiorari for similar reasons, Datapoint has trivialized the entire process of seeking Supreme Court review. When considered with Datapoint's efforts to recall the Federal Circuit's mandate in this case while it seeks review in this Court,[4] it is apparent that Datapoint's petition is nothing more than a thinly disguised attempt to postpone the proceedings on remand in the district court.

Accordingly, because this case presents no reviewable issue for the Supreme Court, the petition for certiorari should be denied.

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[4] Datapoint has filed a motion in the Federal Circuit to recall the court's mandate in the mistaken belief that a petition for certiorari filed within seven days after rehearing is denied, but before the mandate issues, will automatically stay the mandate. Respondent Northern Telecom Inc. has opposed this motion.

CONCLUSION

For the foregoing reasons, the petition for certiorari should be denied.

Respectfully submitted,

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